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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,107	02/11/2004	Lonnie E. Jarvis		2821

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THOMTE, MAZOUR & NIEBERGALL, L.L.C.  
2120 S. 72ND STREET, SUITE 1111  
OMAHA, NE 68124

EXAMINER

PARKER, FREDERICK JOHN

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/776,107

Applicant(s)

JARVIS ET AL

Examiner

Frederick J. Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-5-03</u> . | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 is vague and indefinite because the wording is ambiguous as to whether the polyurethane masked member is subsequently actually put through a galvanizing step, or whether it merely needs to be capable of being galvanized; the precise meaning of “adhesive” in context is unclear since any material which adheres or sticks to the substrate in any form would broadly be considered an adhesive.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seiichi JP 06-235055\* (citations refer to machine translation) in view of Horiki et al US 5091220.

Seiichi teaches that metal tubular articles that are to be galvanized require surfaces to be masked to prevent deposition of metal from the plating bath. In the second embodiment, the use of "cheap plastics" of thermoset or thermoplastic (encompassing polyurethane ) resins which are adherent to the metal in the form of solidified molten coatings [0014] are used as maskants. A polyurethane resin is not explicitly taught. However, Horiki et al teaches a masking system for protecting surfaces undergoing coating, **plating**, phosphatizing, etc in which the plastic masking material comprises polyurethane (col. 1, 9-13; col. 4, 26-43), and may include inorganics (talc or magnesium silicate, bentonite clay, etc). Since Seiichi teaches masking tubular surfaces to be galvanized with thermoplastic maskant coatings, and Horiki et al teaches that thermoplastic

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polyurethane polymer is a suitable maskant material in similar coating applications, it would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Seiichi using polyurethane as the maskant coating material as taught by

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Horiki et al because of the expectation of successfully masking surfaces in the galvanizing process.

As to claim 3, the portions to be masked are not limited and would therefore have included threaded portions in order to assure easier joining of parts.

As to claims 4-6, since Seiichi teaches tubular members, the specific members of claims 4-6 would have been obvious variations to the skilled practitioner because the geometry and overall shape of a tube, pole, or irrigation pipe are essentially the same, so that coating similar shapes would have been expected to provide similar process results.

\* The Examiner notes that while the machine translation of JP06-23505 is not ideal, it is understandable, particularly when read in view of the abstracts, and therefore meets the USPTO requirement of translation of foreign documents.

7. Claims 7-8 distinguish over the prior art which does not teach nor suggest the composition components of the polyurethane maskant of claim 7. The claims are objected to for depending from a rejected base claim.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426.

The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 571/272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick J. Parker  
Primary Examiner  
Art Unit 1762

fjp